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09/769,093	01/24/2001	Stanley C. Baker	BC-1	6390

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EXAMINER

MANNING, JOHN

ART UNIT PAPER NUMBER

2614

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,093

Applicant(s)

BAKER ET AL.

Examiner

John Manning

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/04/2004 have been fully considered but they are not persuasive.

The Applicant argues that the claimed "selections means" is not inherent to the Elendering reference. Elendering discloses: "Consumer profile server 130 can contain a consumer profile which is determined from observation of the consumer's viewing habits on television 108 or consumer PC 104. Such a characterization is frequently referred to as a subscriber characterization, since it is a profile which is obtained by monitoring the viewing habits of a subscriber. In a preferred embodiment, the channels or web sites viewed by a subscriber are monitored, and heuristic rules are applied to the sites to better determine the demographic and product preference characteristics of the subscriber" (Col 4, Lines 37-46). The consumer profile is determined from observation of the consumer's viewing habits. For the consumer profile to exist, the consumer must select a channel of web site. Applicant asserts that statement that the applicability of the advertisement is equivalent to the consumer demand. If a particular advertisement is more applicable to an individual or group, the interest in the advertisement will increase as will the demand. It is argued the "Applicant's system relies on statistics derived from an ensemble of consumers". It is noted that the features upon which applicant relies (i.e., statistics derived from an ensemble of consumers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

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USPQ2d 1057 (Fed. Cir. 1993). In response to applicant's argument, with respect to claim 2 and 4, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldering (US Pat No 6,324,519).

In regard to claim 1, the claimed step of "means for owners of audio / multimedia content to load said content onto the exchange website" is met by Figure 1A items 160 and 162. "A content/opportunity provider 160 maintains the content server 162 which can transmit content including broadcast programming across a network such as the

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Internet 150. Other methods of data transport can be used including private data networks and can connect the content sever 160 through an access system to a device owned by consumer 100" (Col 3, Lines 11-16). The claimed step of "means for sponsors of advertising content to load advertising content to the exchange website for merging with said audio 1 multimedia content to provide standard packaged programs for viewer / player device formats" is met by Figure 1, Items 144 and 146. "The ability to insert an advertisement in a broadcast stream (video, audio, or mailed) is an opportunity for advertiser 144. Content can also be broadcast over the Internet and combined with existing video services, in which case opportunities for the insertion of advertisements will be present" (Col 3, Lines 32-37). The claimed steps of "selection means for consumers to select and schedule mode and method of playing said packaged programs on a player/viewer device" and "record keeping means responsive to selection means for providing a data record of consumer selected programs" is met by Figure 1A, Items 100 and 130. The selection means is inherent to the reference. The user profile acts as the record keeping means. "Consumer profile server 130 can contain a consumer profile which is determined from observation of the consumer's viewing habits on television 108 or consumer PC 104. Such a characterization is frequently referred to as a subscriber characterization, since it is a profile which is obtained by monitoring the viewing habits of a subscriber. In a preferred embodiment, the channels or web sites viewed by a subscriber are monitored, and heuristic rules are applied to the sites to better determine the demographic and product preference characteristics of the subscriber" (Col 4, Lines 37-46). The claimed step of "Automatic

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Control System means responsive to the record keeping means for setting prices for allocated advertising slots based on said consumer demand, such that sponsors chose available audio / multimedia content for the embedment of advertising content based upon consumer demand and consumers receive audio / multimedia content paid for by sponsors of embedded advertisements” is met by Figure 1A, Items 160, 144, and 100. “The content/opportunity provider 160 can charge advertiser 144 for access to consumer 100 during an opportunity. In a preferred embodiment the price charged for access to consumer 100 by content/opportunity provider varies as a function of the applicability of the advertisement to consumer 100” (Col 3, Lines 57-62). Where the applicability of the advertisement is equivalent to the consumer demand.

In regard to claim 3, Eldering discloses determining a price for the advertisement based on applicability/consumer demand. The applicability/consumer demand is determined using a consumer profile. The consumer profile contains viewer characteristic, including time information. “Based on the viewing characteristics of the subscriber, and in particular on the viewing time duration, or time spent on each channel or site, a subscriber profile is formed and updated” (Col 4, Lines 46-49).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering in view of Mackintosh (US Pat No 6,349,329).

In regard to claim 2, The Eldering reference discloses a system for the distribution of audio / multimedia content over a computer network for providing consumers with audio / multimedia programs from owners of multimedia content through sponsor supported embedded advertising content in the packaged programs. The reference fails to explicitly disclose search means for searching audio / multimedia content. The Mackintosh reference teaches search means for searching audio / multimedia content so as to facilitate the acquisition of audio / multimedia content desired by the user. If "a listener is particularly fond of the selection being played, that listener can search for other titles or artists who also have a similar sound, style, or feel. This embodiment can use a data base that provides relational information for the various artists based on their style, sound, or other features or characteristics of the artist. In an extension of this embodiment, the user or listener may also be provided with the ability to click to select sample sound tracks from various other artists or albums that are selected in this manner" (Col 15, Lines 12-25). Consequently, it would have been obvious to one of ordinary skill in the art to implement Eldering with search means for searching audio / multimedia content so as to facilitate the acquisition of audio / multimedia content desired by the user.

In regard to claim 4, the claimed limitation of "a plurality of owner audio / multimedia content providers communicatively linked over the network and the exchange portal" is met by Figure 1A items 160 and 162. "A content/opportunity

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provider 160 maintains the content server 162 which can transmit content including broadcast programming across a network such as the Internet 150. Other methods of data transport can be used including private data networks and can connect the content sever 160 through an access system to a device owned by consumer 100" (Col 3, Lines 11-16). The reference fails to explicitly disclose search means for searching audio / multimedia content. The Mackintosh reference teaches search means for searching audio / multimedia content so as to facilitate the acquisition of audio / multimedia content desired by the user. If "a listener is particularly fond of the selection being played, that listener can search for other titles or artists who also have a similar sound, style, or feel. This embodiment can use a data base that provides relational information for the various artists based on their style, sound, or other features or characteristics of the artist. In an extension of this embodiment, the user or listener may also be provided with the ability to click to select sample sound tracks from various other artists or albums that are selected in this manner" (Col 15, Lines 12-25). Consequently, it would have been obvious to one of ordinary skill in the art to implement Eldering with search means for searching audio / multimedia content so as to facilitate the acquisition of audio / multimedia content desired by the user. The claimed step of "a means responsive to the search engine means for collecting consumer request information to thereby set ad slot pricing for sponsors of the merged content stream, such that consumers using said communication network obtain selected audio / multimedia content by accessing the portal service and receive said integrated content paid for by sponsor embedded advertisements" is met by Figure 1A, Items 160, 144, and 100.

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"The content/opportunity provider 160 can charge advertiser 144 for access to consumer 100 during an opportunity. In a preferred embodiment the price charged for access to consumer 100 by content/opportunity provider varies as a function of the applicability of the advertisement to consumer 100" (Col 3, Lines 57-62). Where the applicability of the advertisement is equivalent to the consumer demand.

6. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering.

In regard to claim 5, the claimed step of "means for owners of audio / multimedia content to load said content onto the exchange website" is met by Figure 1A items 160 and 162. "A content/opportunity provider 160 maintains the content server 162 which can transmit content including broadcast programming across a network such as the Internet 150. Other methods of data transport can be used including private data networks and can connect the content sever 160 through an access system to a device owned by consumer 100" (Col 3, Lines 11-16). The claimed limitations of "record keeping means communicatively linked with the website for providing sponsors with statistics of consumer transactions for said audio / multimedia content" and "means for sponsors to chose said available audio / multimedia content for the embedment of advertising based on consumer transactions for said audio / multimedia content" are met by the consumer profile. The claimed limitation of "means for sponsors to load advertising content onto said exchange website for merging with audio 1 multimedia content to provide packaged programs in standard viewer/player device formats requested by consumers" is met by Figure 1, Items 144 and 146. "The ability to insert

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an advertisement in a broadcast stream (video, audio, or mailed) is an opportunity for advertiser 144. Content can also be broadcast over the Internet and combined with existing video services, in which case opportunities for the insertion of advertisements will be present" (Col 3, Lines 32-37). The claimed limitations of "means for consumers to select the integrated audio / multimedia content for playback" and "Automatic Control System means responsive to the record keeping means for setting prices for allocated advertising slots based on consumer demand" is met by Figure 1A, Items 100 and 130. The selection means is inherent to the reference. The user profile acts as the record keeping means. "Consumer profile server 130 can contain a consumer profile which is determined from observation of the consumer's viewing habits on television 108 or consumer PC 104. Such a characterization is frequently referred to as a subscriber characterization, since it is a profile which is obtained by monitoring the viewing habits of a subscriber. In a preferred embodiment, the channels or web sites viewed by a subscriber are monitored, and heuristic rules are applied to the sites to better determine the demographic and product preference characteristics of the subscriber" (Col 4, Lines 37-46). Eldering discloses the integration of audio / multimedia content and advertising content. The reference fails to explicitly disclose formatting the integrated content into standard audio / multimedia streams compatible with consumer player/viewer devices; however, the examiner takes official notice that it is notoriously well known in the art to format the multimedia content into standard streams compatible with consumer player/viewer devices so as to ensure the user device can process the content. Consequently, it would have been obvious to one of ordinary skill in the art to implement

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Eldering with formatting the integrated content into standard audio / multimedia streams compatible with consumer player/viewer devices so as to ensure the user device can process the content.

In regard to claim 6, the claimed limitation of "a website providing an exchange for authors and owners of audio/ multimedia program, to make the programs available to consumers, each program comprising one or more embedded advertising slots" is met by Figure 1A items 160 and 162. "A content/opportunity provider 160 maintains the content server 162 which can transmit content including broadcast programming across a network such as the Internet 150. Other methods of data transport can be used including private data networks and can connect the content sever 160 through an access system to a device owned by consumer 100" (Col 3, Lines 11-16). The claimed step of "record keeping means communicatively linked with the website for enabling sponsors to know the distribution of audio / multimedia programs selected by consumers" is met by Figure 1A, Items 100 and 130. The user profile acts as the record keeping means. "Consumer profile server 130 can contain a consumer profile which is determined from observation of the consumer's viewing habits on television 108 or consumer PC 104. Such a characterization is frequently referred to as a subscriber characterization, since it is a profile which is obtained by monitoring the viewing habits of a subscriber. In a preferred embodiment, the channels or web sites viewed by a subscriber are monitored, and heuristic rules are applied to the sites to better determine the demographic and product preference characteristics of the subscriber" (Col 4, Lines 37-46). The claimed limitation of "feedback means, linked with a means for providing

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sponsors with said embedded advertising slots, said feedback means for providing a record of the number of times selected audio / multimedia programs are downloaded, such that available embedded advertising slots can be competitively priced to sponsors based on consumer distribution "is met by Figure 1A, Items 160, 144, and 100. "The content/opportunity provider 160 can charge advertiser 144 for access to consumer 100 during an opportunity. In a preferred embodiment the price charged for access to consumer 100 by content/opportunity provider varies as a function of the applicability of the advertisement to consumer 100" (Col 3, Lines 57-62). Where the applicability of the advertisement is equivalent to the consumer demand.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 571-272-7352. The examiner can normally be reached on M-F: 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM
June 26, 2005


JOHN MILLER
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